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10/659,654	09/10/2003	Gregory A. Piccionelli	39003.811US01	3656

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MICHAEL M. GERARDI, ESQ.
2801 TOWNSGATE ROAD
SUITE 200
WESTLAKE VILLAGE, CA 91361

EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

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09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,654	Applicant(s) PICCIONELLI ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11-18 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11-18, and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the 'Amendment and Request for Reconsideration' filed on 29 December 2008 ("08 Dec Response") and the 'Supplemental Response and Request for Reconsideration' filed on 27 May 2009 ("09 May Response").
2. Claims 2-9, 11-18, and 29-32 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090916. This Paper No. is for reference purposes only.

Restrictions

4. In light of the 08 Dec Response, the Restriction Requirement of the previous Office action mailed on 25 June 2008 is hereby withdrawn.

Claim Rejections - 35 USC §103

5. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 7, 9, 16-18, 29, 31, and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richey et al. (U.S. 2003/0233292 A1) ("Richey"), in view of Dunn et al. (U.S. 2002/0082911 A1) ("Dunn").

Regarding Claims 9, 29, 31, and 32

7. Richey discloses:

shipping a tangible good associated with a merchant (¶¶ 0056, 0086 and 0087),
creating a record of the shipment of the tangible good to a user (the creation of the record is inherent to the disclosure of Richey's "merchandise delivery data"; if the data exists, then the creating function is necessarily present – ¶¶ 0056, 0086 and 0087),
receiving a charge-back request from the user, the charge-back request comprising a reason for the charge-back request (fig. 1 – "2. Cardholder initiates dispute," fig. 7),
associating the charge-back request with the record of the shipment of the tangible good to the user (¶ 0086),
examining the reason for the charge-back request (fig. 5, ¶ 0088), and
denying the charge-back request when the reason includes an assertion that the user did not request the tangible good (fig. 7, *e.g.*, "Cardholder Does Not Recognize Transaction"; ¶ 0089 – discussion of "representments").

8. Richey does not directly disclose:

providing a membership in a destination site on a network to a user requesting the membership, wherein the user requests the membership by
accessing an affiliate site on a network the affiliate site including a hyperlink to the destination site, and
accessing the destination site by activating the hyperlink,

Art Unit: 3621

shipping a tangible good associated with the membership in the destination site to the user.

9. Dunn teaches:

providing a membership in a destination site on a network to a user requesting the membership (§ 0026), wherein the user requests the membership by

accessing an affiliate site on a network the affiliate site including a hyperlink to the destination site (fig. 3), and

accessing the destination site by activating the hyperlink (fig. 3),

shipping a tangible good associated with the membership in the destination site to the user (§§ 0027, 0038).

10. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to apply the method of processing charge-backs, as disclosed by Richey, to the method of providing a membership and tangible goods, as taught by Dunn. One would have been motivated to do so because the method of Richey prevents fraudulent charge-backs.

Regarding Claims 6 and 16

11. The combination of Richey and Dunn discloses the limitations of claims 9 and 29, as shown above, and further discloses wherein in step b) a tangible good is provided to the user periodically (Dunn, § 0159).

Regarding Claims 7 and 17

12. The combination of Richey and Dunn discloses the limitations of claims 9 and 29, as shown above, and further discloses wherein in step b) the membership in the site is renewed periodically (Dunn, ¶¶ 0026, 0159).

Regarding Claim 18

13. The combination of Richey and Dunn discloses the limitations of claim 9, as shown above, and further discloses wherein providing a valuable consideration to the affiliate site after step b) (Dunn, fig. 3).

14. Claims 2-5 and 11-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Richey and Dunn, in further view of Guerreri (U.S. 2002/0055911 A1).

Regarding Claims 2 and 11

15. The combination of Richey and Dunn discloses the limitations of claim 9, as shown above.

16. Richey does not directly disclose wherein the tangible good is a digital storage device.

17. Guerreri teaches wherein a tangible good is a digital storage device (¶ 0033).

18. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the storage device of Guerreri for the goods of Richey. Thus, the simple

Art Unit: 3621

substitution of one known element for another, producing predictable results, renders the claim obvious.

Regarding Claims 3 and 12

19. The combination of Richey, Dunn, and Guerreri discloses the limitations of claim 11, as shown above, and further discloses wherein the digital storage device is a CD-ROM (Guerreri, ¶ 0033).

Regarding Claims 4 and 13

20. The combination of Richey, Dunn, and Guerreri discloses the limitations of claim 12, as shown above, and further discloses wherein the CD-ROM includes at least one digital data file (see Guerreri, ¶ 0033).

Regarding Claims 5 and 14

21. The combination of Richey, Dunn, and Guerreri discloses the limitations of claim 13, as shown above, and further discloses wherein the digital data file is selected from the group consisting of an audio file, a video file, a photographic file, a graphic file and a text file (see Guerreri, ¶ 0033).

Art Unit: 3621

Regarding Claim 15

22. The combination of Richey, Dunn, and Guerreri discloses the limitations of claim 12, as shown above, and further discloses wherein the CD-ROM includes a hyperlink to a third-party site or a network (see Guerreri, ¶ 0033).

23. Claims 8 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Richey and Dunn, in further view of Feathers et al. (U.S. 2002/0055933 A1) (“Feathers”).

Regarding Claims 8 and 30

24. The combination of Richey and Dunn discloses the limitations of claim 29, as shown above.

25. Richey and Dunn do not directly disclose:

wherein a user acquiring the membership in the destination site is associated with a password that identifies the user and the affiliate site.

26. Feathers teaches:

wherein a user acquiring a good in a destination site is associated with a password that identifies the user and the affiliate site (Feathers, ¶ 0015).

27. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of Dunn to include the password of Feathers. One would have been motivated to do so because the password enables the affiliate to collect payment for the referral (Feathers, ¶ 0015).

Claim Interpretation

28. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

29. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

30. Regarding the conditional elements in the claims (*e.g.* claim 9 recites “denying... *when* the reason includes an assertion...” (emphasis added)), they too have been considered. However, Applicants are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” [emphasis in original].

31. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these definitions are only a guide to claim

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

Art Unit: 3621

terminology since claim terms must be interpreted in context of the surrounding claim language.

Finally, the following list is not intended to be exhaustive in any way:

associate “4 : to bring together or into relationship in any of various intangible ways (as in memory or imagination).” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986;

when: “2 : in the event that: IF.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

32. Applicants’ arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

33. Applicants’ 08 Dec Response necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

34. Because this application is now final, Applicants are reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal

Art Unit: 3621

requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

35. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

37. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

Art Unit: 3621

Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
September 16, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621